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In re Application of :
HARDER, Claus, et al. :
U.S. Application No.: 10/535,084 :
PCT No.: PCT/EP03/12532 :
International Filing Date: 10 November 2003 :
Priority Date: 13 November 2002 :
Attorney's Docket No.: 117163.00137 :
For: USE OF ONE OR MORE ELEMENTS FROM :
THE GROUP CONTAINING YTTRIUM, :
NEODYMIUM AND ZIRCONIUM AND :
PHARMACEUTICAL COMPOSITIONS :
CONTAINING SAID ELEMENTS :
:

COMMUNICATION
REGARDING SUBMISSION
UNDER 37 CFR 1.42

This communication is issued in response to applicants' submission on 08 December 2005 of a declaration executed on behalf of deceased inventor Bernd HEUBLEIN by his heirs, which has been treated as a submission under 37 CFR 1.42.

BACKGROUND

On 10 November 2003, applicants filed international application PCT/EP03/12532. The application claimed a priority date of 13 November 2002 and designated the United States. On 27 May 2004, the International Bureau ("IB") communicated a copy of the international application to the United States Patent And Trademark Office ("USPTO"). The deadline for payment of the basic national fee was 13 May 2005 (i.e., thirty months from the priority date).

On 13 May 2005, applicants filed a transmittal letter for entry into the national stage in the United States accompanied by, among other materials, payment of the basic national fee.

On 05 October 2005, the United States Designated/Elected Office (DO/EO/US) mailed a "Notification Of Missing Requirements (Form PCT/DO/EO/905) requiring the following: (1) a translation into English of the international application; (2) the processing fee for filing the translation later than thirty months after the priority date; (3) an oath or declaration in compliance with 37 CFR 1.497; and (4) the surcharge for filing the oath or declaration later than thirty months after the priority date.

On 08 December 2005, applicants filed a response to the Notification Of Missing Requirements. The response included an English translation of the international application,

payment of the required surcharge and processing fees, and a declaration. The declaration was executed by surviving applicant Claus HARDER and on behalf of the deceased inventor Bernd HEUBLEIN by three persons identified as heirs: Eva HEUBLEIN, Nora HEUBLEIN, and Christoph HEUBLEIN. This declaration is considered herein under 37 CFR 1.42 and 1.497.

DISCUSSION

37 CFR 1.42 *When the Inventor is Dead*, states, in part:

In case of the death of the inventor, the legal representative (executor, administrator, etc.) of the deceased inventor may make the necessary oath or declaration, and apply for and obtain the patent.

Section 409.01(a) of the Manual of Patent Examining Procedure (MPEP) states that the application can also be executed by all of the heirs of the deceased inventor, where no legal representative has been appointed or is required to be appointed by law.

37 CFR 1.497(b)(2) states the following:

(2) If the person making the oath or declaration or any supplemental oath or declaration is not the inventor (§§ 1.42, 1.43, or § 1.47) the oath or declaration shall state the relationship of the person to the inventor, and, upon information and belief, the facts which the inventor would have been required to state. If the person signing is the legal representative of a deceased inventor, the oath or declaration shall also state that the person is a legal representative and the citizenship, residence, and mailing address of the legal representative.

Pursuant to 37 CFR 1.497(b)(2), the citizenship for **both** the deceased inventor and the legal representative (or heirs) must be identified on the declaration (as well as the mailing address and residence information of the legal representative and all other information required under 37 CFR 1.497).

Here, the declaration filed 06 January 2006 includes the required citizenship, residence, and mailing address information for the surviving inventor and the persons signing the declaration on behalf of the deceased inventor. However, the declaration does not set forth the citizenship of the deceased inventor. In addition, neither the declaration nor any materials submitted therewith state that the three heirs listed in the declaration are the only heirs of the deceased inventor. Applicants must provide a revised declaration that includes all required information, including the citizenship of the deceased inventor. Such declaration must also make clear on its face (or be accompanied by a statement and/or supporting documentation confirming) that the persons executing the declaration on behalf of the deceased inventor are the only heirs of the deceased inventor.

It is also noted that the copy of the declaration in the application file is incomplete; page "2 of 3" (and the required language contained thereon) is missing. Any revised declaration filed herein must be complete.

CONCLUSION

For the reasons discussed above, the request for status under 37 CFR 1.42 is **DISMISSED** without prejudice.

Applicants have **TWO (2) MONTHS** from the mailing date of this communication to submit a proper response under 37 CFR 1.42 and 37 CFR 1.497. Failure to provide a proper and timely response will result in abandonment. Extensions of time are available under 37 CFR 1.136(a).

A proper response must include a revised and re-executed declaration that includes all the information required by 37 CFR 1.497 (including the citizenship of the deceased inventor) as well as a statement and/or supporting documentation confirming that the persons executing the declaration on behalf of the deceased inventor are the only heirs of the deceased inventor.

Any further correspondence with respect to this matter should be addressed to Mail Stop PCT, Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration



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